REMARKS:

In the outstanding Office Action, the Examiner rejected claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24. Claims 1, 8, 15 and 22-24 are amended herein, and new claim 25 is added. Claims 2, 3, 5, 6, 9, 10, 12, 13, 16, 17, 19 and 20 remain cancelled. No new matter is presented.

Thus, claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-25 are pending and under consideration. The rejections are traversed below.

REJECTION UNDER 35 U.S.C. § 112¶2:

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24 were rejected under § 112¶2 as being indefinite. Claims 1, 8, 15, 22 and 23 are amended herein and the rejection of claims 23 and 24 is traversed below. Claims 4, 7, 11, 14, 18 and 21 depend from amended claims 1, 8 and 15.

The claimed method of claim 23 includes, "printing a stored electronic document as a printed document", "making a handwritten note on the printed document where the handwritten note is not included in the electronic document" and "scanning the printed document including the handwritten note." The claimed method of claim 23 further recites, "extracting the handwritten note from the scanned printed document by determining a difference between the electronic document and the scanned printed document" and "storing the extracted handwritten note and the recognized character linked to the electronic document, wherein contents of the electronic document and the recognized character are searched in accordance with a search keyword input from a user."

The invention claimed in independent claim 24 includes, "scanning a printed version of an electronic document including a handwritten note" and "performing character recognition on the handwritten note producing a recognized character." The method of claim 24 further includes, "determining a difference between the electronic document and the scanned printed document including the handwritten note and storing the handwritten note and recognized character linked to the electronic document", thereby enabling "a search of contents of the electronic document and the recognized character using a search keyword input from a user."

As indicated by the recitation of claims 23 and 24 above, the claims are directed to a method for managing a document including "a handwritten note" placed on the document subsequent to printing the document.

The preamble "A method, comprising" in conjunction with the above-discussed features recited in the body of claims 23 and 24 clearly sets forth and particularly points out the subject matter of the invention to one of ordinary skill in the art to comply with the requirements of 35 U.S.C. § 112¶2 (see, MPEP § 2171).

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 4, 7, 8, 11, 14, 15, 18 and 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,533,168 (<u>Ching</u>) and U.S. Patent No. 4,748,678 (<u>Takeda</u>).

Ching is directed to tracking data associated with retail transactions including annotations made directly on a receipt that are stored with the transaction data based on predetermined relationships specified by a user or in a single document (see, col. 4, lines 9-18). For example, if a transaction involves a return of merchandise, the dataform from a prior transaction receipt is read to obtain relevant transaction information about the prior transaction (see, col. 8, lines 13-43). That is, Ching is limited to retrieving transaction data using identifiers printed on a receipt at the time of the transaction.

The Examiner acknowledges that <u>Ching</u> does not explicitly teach correlating the original document with the information about the note and that the image data of the note is obtained by taking a difference between the original document and the read image, but relies on <u>Takeda</u> as teaching the same. However, <u>Takeda</u> is directed to using secondary data as index data relating to a document image for retrieving the document image by using the secondary data. For example, as shown in FIG. 11, the secondary data file (90) consists of coordinates specifying local regions of an original image from which the secondary data is extracted, and when a document image is to be retrieved, the local regions of the secondary data (90) is used to extract contents from the document image (see, col. 9, lines 36-65 and col. 10, 46-58). That is, <u>Takeda</u> is limited to retrieving the original document using the secondary data as an index based on positional regions or attributes of the secondary data.

The present invention electronically manages both the handwritten note and the electronic document.

Independent claim 1, by way of example, recites "extracting information about the note from the read image of the document printed on the paper, the note being hand-written on the

paper" and "correlating and electronically storing the electronic document not including the hand-written note and the information about the hand-written note including a character recognition result." As further recited in claim 1, the present invention includes, "searching contents of the electronic document and the recognition result of character contents of the hand-written note in accordance with a search keyword input from a user", where "the image data of the hand-written note is obtained by taking a difference between a generated image generated from the electronic document and the read image."

Independent claims 8, 15 and 22-24 also recite that the present invention enables searching "contents of the electronic document and the recognition result of character contents of the hand-written note" based on "a search keyword input from a user".

<u>Ching</u> and <u>Takeda</u>, alone or in combination, do not teach or suggest the above-discussed features of the independent claims.

It is submitted that independent claims 1, 8, 15 and 22-24 are patentably distinguishable over <u>Ching</u> and <u>Takeda</u>.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over the cited references. The dependent claims are also independently patentable. For example, as recited in claim 7, "the information about the handwritten note includes location information indicating a location of the hand-written note within a printed document." These features of claim 7 are not taught or suggested by the cited references.

Therefore, withdrawal of the rejection is respectfully requested.

NEW CLAIM:

New claim 25 has been added to emphasize that the present invention includes, "extracting information of a handwritten note on a document subsequent to printing the document" based on comparison of "the document with a corresponding document prior to said printing, the corresponding document being without the handwritten note." Accordingly, upon an input keyword, the present invention searches for the keyword using "contents of the corresponding document and a character recognition indicating character contents of the note handwritten on the printed document".

<u>Ching</u> and <u>Takeda</u>, alone or in combination, do not teach or suggest, "extracting information of a handwritten note on a document subsequent to printing the document" and

Serial No. 09/961,319

"searching for a keyword within contents of the corresponding document and a character recognition indicating character contents of the note handwritten on the printed document", as recited in new claim 25.

Therefore, it is submitted that new claim 25 is patentably distinguishable over <u>Ching</u> and <u>Takeda</u>.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 06/04/2006

Temnit Afework

Registration No. 58,202

1201 New York Avenue, NW, 7th Floor

Washington, D.C. 20005 Telephone: (202) 434-1500

Facsimile: (202) 434-1501